UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BERND GOTTSELIG, BING CHANG XU, FRANK KOVACIC, HOLLY ZHANG, JOHN LINCOLN NELSON, PRATAPA SRIKIRAN and RICHARD J. GILBERT

Appeal No. 2005-2016
Application No. 09/682,988

ON BRIEF

Before FRANKFORT, McQUADE, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18, which are all of the claims pending in this application.

We REVERSE AND REMAND.

BACKGROUND

The appellants' invention relates to a method and system of restricted substance management and recycling in a manufacturing corporate environment (appellants' specification, page 1). The method includes the steps of inputting restricted substance and recycle content data of parts supplied by a supplier for a vehicle into a computer system of the vehicle manufacturer, reviewing the inputted data and determining (i.e., identifying) parts with banned or recycled content or substances over predetermined thresholds and reporting the determined parts to the supplier and the vehicle manufacturer. The reporting includes sending a notification of compliance if the result of the reviewing step is that there are no determined parts and sending a notification of non-compliance if there are determined parts. Independent claims 1, 17 and 18 are representative with respect to the issues on appeal and are reproduced, *infra*, in the opinion section of this decision.

The Evidence

The prior art references of record relied upon by the examiner as evidence of obviousness in rejecting the appealed claims are:

Fukatsu et al. (Fukatsu)	2002/0052666	May 2, 2002
Farmer et al. (Farmer)	2003/0004965	Jan. 2, 2003

The Rejections

Claims 1-10 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fukatsu.

Claims 11-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fukatsu in view of Farmer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 12, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed June 3, 2004) and reply brief (filed October 18, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Independent claims 1, 17 and 18 read as follows:

> 1. A computer method of restricted substance management and recycling in a vehicle manufacturing environment, said method comprising the steps of:

inputting restricted substances and recycle content data of parts supplied by a vehicle supplier for a vehicle into a computer system of a vehicle manufacturer;

reviewing the inputted data and determining parts with banned or recycled content or substances over predetermined thresholds; and

reporting the determined parts to the vehicle supplier and the vehicle manufacture [*sic*: manufacturer].

17. A computer method of restricted substance management and recycling in a vehicle manufacturing environment, said method comprising the steps of:

inputting data of restricted substances and recycle content of parts supplied by a vehicle supplier for a vehicle into a computer system of a vehicle manufacturer;

validating the inputted data;

saving partial inputted data;

acknowledging receipt of inputted data by the vehicle manufacturer to the vehicle supplier;

reviewing the inputted data and determining parts with banned or recycled content or substances over predetermined thresholds;

sending a non-compliance notification to the vehicle supplier and the vehicle manufacturer if there are determined parts; and

sending a compliance notification to the vehicle supplier and the vehicle manufacturer if there are no determined parts.

> 18. A system for restricted substance management and recycling in a vehicle manufacturing environment, said system comprising:
>
> a computer system for inputting restricted substances and recycle content data of parts supplied by a vehicle supplier for a vehicle, for reviewing the inputted data and determining parts with banned or recycled content or substances over predetermined thresholds, and for reporting the determined parts to the vehicle supplier and the vehicle manufacture [*sic*: manufacturer].

We turn first to the examiner's rejection of claims 1-10 as being unpatentable over Fukatsu. Fukatsu discloses an environmental information system for use in a corporate procurement environment [paragraph 0093]. The system includes a database of parts and material information on those parts, including whether such material is recycled material, a substance to be reduced, a substance to be controlled or a prohibited substance and including recycled material content (see, e.g., Figure 15). In addition to permitting the user to query the system for material content of a particular selected part, Fukatsu's system permits the user to query the system for all parts containing a particular selected substance, which substance can be, for example, a prohibited substance, such as asbestos, or a substance to be reduced, such as mercury (see, e.g., Figure 17). Fukatsu does not specify use of the disclosed system in

a vehicle manufacturing environment[1] and does not disclose a step of reviewing the inputted part information and determining (i.e., identifying) parts with banned or recycled content or substances over predetermined thresholds, as called for in claim 1. In particular, while Fukatsu discloses a query format wherein the system searches the database for all parts containing a particular substance identified by the user, there is no disclosure in Fukatsu of a comprehensive screening of parts in the database to identify those with banned or recycled content or substances over predetermined thresholds. We appreciate that the Fukatsu system and database, with its Y/N flags for recycled content, prohibited substance, substance to be reduced and substance to be controlled, could probably be used to process such a query, but we find no teaching or suggestion in Fukatsu to do so. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For the foregoing reasons, we cannot sustain the examiner's rejection of claims 1-10 as being unpatentable over Fukatsu. The examiner's rejection of independent

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[1] One of ordinary skill in the art, however, would have certainly understood from Fukatsu's disclosure that Fukatsu's system is suitable for use in procurement in any design or manufacturing environment, including the vehicle manufacturing environment.

claim 18 is grounded in part on the examiner's finding that Fukatsu discloses reviewing the inputted data and determining parts with banned or recycled content or substances over predetermined thresholds. The above discussed lack of support in Fukatsu for this finding fatally taints the examiner's conclusion that the differences between the subject matter recited in claim 18 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Thus, the rejection of claim 18 as being unpatentable over Fukatsu also cannot be sustained.

The examiner's application of Farmer provides no cure for the deficiency of Fukatsu discussed above. It follows that the rejection of claims 11-16, which depend indirectly from claim 1, and independent claim 17, which also recites a step of reviewing the inputted data and determining parts with banned or recycled content or substances over predetermined thresholds, as being unpatentable over Fukatsu in view of Farmer also cannot be sustained.

REMAND TO THE EXAMINER

This application is remanded to the examiner, pursuant to 37 CFR § 41.50(a)(1), for consideration of a rejection of claim 18, under 35 U.S.C. § 102, as being anticipated by a conventional computer system known in the art, as evidenced by the admission on page 3 of appellants' specification that "the computer system 12 is conventional and

known in the art." We note that claim 18 does not recite that the computer system is programmed to perform the "inputting," "reviewing and determining" and "reporting" steps. Rather, claim 18 appears to require no more than a computer system capable of performing these steps (i.e., capable of being programmed to perform these steps).

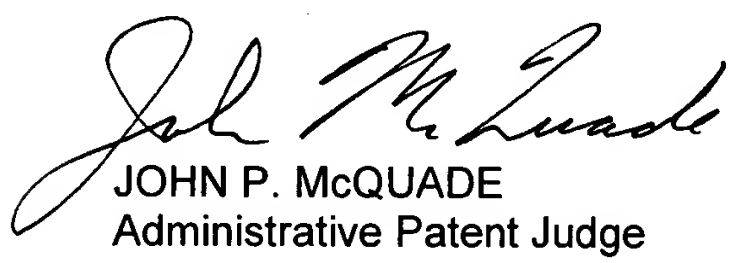
CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18 under 35 U.S.C. § 103 is reversed and the application is remanded for the purpose discussed above.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED AND REMANDED

CHARLES E. FRANKFORT
Administrative Patent Judge



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Administrative Patent Judge

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